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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,764

06/06/2006

Robert J. Cleereman

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The Dow Chemical Company
Intellectual Property Section
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EXAMINER

PRANGE, SHARON M

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

10/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,764	Applicant(s) CLEEREMAN ET AL.	
	Examiner SHARON M. PRANGE	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/6/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is an improper Markush claim, and it is unclear and indefinite because it is not clear which limitations are positively recited in the claim.

Claim 8 is vague and indefinite as it is not clear what structure is being encompassed by such language. It is not clear how the device passes the test. It is also not clear how this is part of a product claim, as it seems to be a method of testing, not a product claim.

Claims 11 and 12 are improper method claims as they do not have any method steps. The phrase "by designing attachment features" in claim 11, line 2 is vague and indefinite as it is not clear what structure is encompassed by such language.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Akihisa (Japanese Publication No. 10-284855).

Akihisa discloses an impact-absorbing insert with an impact-absorbing portion (3) and a tethered plug (9) for insertion into an access tunnel (opening 7) contained in a mating user defined enclosure (case 1). The access tunnel provides access to a feature of the article (jack 8) without opening the case. The insert provides a water and dust tight seal for the article. The housing encloses a portable electronic device. The insert also has an engagement rib (packing 11) and a molded-in button (packing 12).

(Abstract; Fig. 1, 5)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akihisa (Japanese Publication No. 10-284855).

Regarding claims 4, 6 and 8, Akihisa does not specifically disclose the type of electronic device housed in the case, however it would have been obvious to one of ordinary skill in the art at the time of the invention to have housed a camera, instrumentation, tool, etc. in the case as these are all devices commonly stored within a protective case with waterproofing features.

Regarding claim 8, Official Notice is taken that it is old and conventional to have electronic devices pass tests depending on the characteristics and requirements of the device. It would be obvious to test the device and to have the device pass certain tests depending on the requirements and characteristics of the particular device.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akihisa in view of Berberich et al. (US Patent No. 5,760,998), herein Berberich and Brauer et al. (US Patent No. 6,790,916), herein Brauer.

Akihisa does not disclose the material of the insert.

Berberich teaches that an insert (gasket) may be made of an elastomeric material in order to provide both shock absorbing and sealing properties (column 6, lines 33-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the insert of Akihisa of an elastomeric material, as taught by Berberich, in order to provide both shock absorbing and sealing properties to the insert.

The combination of Akihisa and Berberich does not disclose the specific hardness of the elastomeric material.

Brauer teaches that an elastomeric material, specifically a polyurethane elastomer, may have a hardness between 45 and 65 Shore A.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the insert of Akihisa of a polyurethane elastomer of a hardness between 45 and 60 Shore A as this is a well known range of hardnesses at which to produce an elastomeric material.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akihisa in view of Cloud et al. (US Patent No. 5,884,003), herein Cloud.

Akihisa does not disclose the inclusion of fingers and grooves on the insert and enclosure.

Cloud teaches providing fingers (ribs) and grooves (47) on an insert (gasket) which act to improve the retention and sealing ability of the insert (column 5, lines 26-30; Fig. 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided fingers and grooves, as taught by Cloud, on the insert and enclosure of Akihisa in order to improve the retention and sealing of the insert.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharon M Prange/
Examiner, Art Unit 3728

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728